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**THIS DISPOSITION  
IS NOT CITABLE AS PRECEDENT  
OF THE T.T.A.B.**

Paper No. 14  
HWR

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Specialty Tapes, Div. of RSW, Inc.

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Serial No. 75/174,045

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David A. Frey of Jansson, Shupe, Bridge and Munger, Ltd.  
for Specialty Tapes, Div. of RSW, Inc.

Monique C. Miller, Trademark Examining Attorney, Law Office  
108 (David Shallant, Managing Attorney).

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Before Quinn, Walters and Wendel, Administrative Trademark  
Judges.

Opinion by Wendel, Administrative Trademark Judge:

Specialty Tapes, Div. of RSW, Inc. has filed an  
application to register the mark WALLABY WALLET and design,  
as shown below, for "photograph albums."<sup>1</sup>

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<sup>1</sup> Serial No. 75/174,045, filed September 30, 1996, claiming first  
use dates of July 25, 1996. A disclaimer has been made of the  
word WALLET.

Registration has been finally refused under Section 2(d) on the ground of likelihood of confusion with the registered marks shown below:

WALLABY                      for "books";<sup>2</sup>

WALLABIES                      for "paper and cardboard goods, namely, envelopes, calendars, writing pads, folders, greeting cards, index cards, napkins, postcards, posters, scrapbooks and related stationery; mounted and unmounted photographs; plastic materials for packaging, namely, plastic wrap, plastic bubble packs and plastic film and bags for wrapping and packaging items; paper flags; decalcomanias; playing cards; sacks and bags for wrapping and packaging; stickers; almanacs, journals and magazines pertaining to sport, sport coaching manuals and sporting event programs; paper coasters; pens; trading cards." <sup>3</sup>

The refusal has been appealed and applicant and the Examining Attorney have filed briefs. No oral hearing was requested.

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<sup>2</sup> Registration No. 1,151,686, issued April 21, 1981, Section 8 & 15 affidavits accepted and acknowledged, respectively.

<sup>3</sup> Registration No. 2,181,767, issued August 18, 1998.

We make our determination of likelihood of confusion on the basis of those of the *du Pont*<sup>4</sup> factors which are relevant in view of the evidence of record. Two key considerations in any analysis are the similarity or dissimilarity of the respective marks and the similarity or dissimilarity of the goods or services with which the marks are being used. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976); *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999).

Registration No. 1,151,686

Looking first to the respective marks, we are guided by the well established principle that although the marks must be considered in their entirety, there is nothing improper, under appropriate circumstances, in giving more or less weight to a particular portion of a mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Moreover, although descriptive or disclaimed matter cannot be ignored in comparing the marks, it is also a fact that consumers are more likely to rely on the non-descriptive portion of a mark as an indication of source. See *Hilson Research Inc. v. Society for Human Resource*

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<sup>4</sup> *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

Management, 27 USPQ2d 1423 (TTAB 1993). In addition, it is the word portion of a mark, rather than the design features, unless particularly distinctive, that is more likely to be remembered and relied upon by purchasers in referring to the goods and thus it is the word portion that will be accorded more weight in determining the similarity of the involved marks. See *Ceccato v. Manifattura Lane Gaetano Marzotto & Figli S.p.A.*, 32 USPQ2d 1192 (TTAB 1994).

Applying these principles, we are in agreement with the Examining Attorney that the dominant portion of both applicant's mark, WALLABY WALLET and design, and registrant's mark, WALLABY and design, is the term WALLABY. Applicant insists that its mark must be viewed in its entirety and full weight given to the fact that it consists of two words rather than one. Applicant argues that the term WALLET, even though disclaimed, is not descriptive, but at most suggestive, of its product, and must be considered in determining the commercial impression created by its mark.

While a "wallet" may, by dictionary definition, be designed for carrying money, the term has acquired a much more general connotation, namely the basic shape for a carrier for various items. Applicant has acknowledged as

much by its frequent reference to its product as a "photograph wallet." (For example, see brief p. 8). Thus, we are convinced that purchasers would look to the term WALLABY, which is arbitrary in relation to these goods, as the indication of source and would view WALLET simply as descriptive of the form of the photograph album. Although applicant argues that purchasers would request a WALLABY WALLET and not a WALLABY, it does not follow as a conclusion therefrom that these purchasers would view the term WALLET as anything other than a descriptor of the goods.<sup>5</sup>

Insofar as the respective "wallaby" designs are concerned, we concur with the Examining Attorney that these two designs should not be accorded as much weight as the word portion of the marks, in that purchasers would use the word portions to call for the goods. In addition, as she points out, the main function of the design portions, being pictures of wallabies, is to reinforce the word portions and the general commercial impression created by the term WALLABY. See *Ceccato v. Manifatture Lane Gaetano Marzotto*

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<sup>5</sup> Applicant's reliance on *Alpha Industries, Inc. v. Alpha Steel Tube & Shapes, Inc.*, 616 F.2d 440, 205 USPQ 981 (9<sup>th</sup> Cir 1980) is misplaced. There the additional words in the second mark were found to be "significant words, indicating a different origin, not merely descriptive words." Furthermore, that was an infringement case, in which different factors are taken under consideration.

& Figli S.p.A., *supra* (coat of arms design reinforces meaning of word mark). Both designs, despite the specific visual differences in the two "wallaby" designs, serve the same purpose.

Thus, we find the overall commercial impressions created by the respective marks to be highly similar.

Turning to the goods involved, we note that as a general principle, the issue of likelihood of confusion must be determined on the basis of the goods as identified in the application and in the cited registration(s). *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed.Cir. 1987). It is not necessary that the goods of the applicant and registrant be similar or even competitive to support a holding of likelihood of confusion. It is sufficient if the respective goods are related in some manner and/or that the conditions surrounding their marketing are such that they would be encountered by the same persons under circumstances that could, because of the similarity of the marks used thereon, give rise to the mistaken belief that they emanate, or are associated with, the same source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993) and the cases cited therein. If there are no restrictions in the application or registration(s) as to channels of

trade, the parties' goods must be assumed to travel in all the normal channels of trade for goods of this nature. See Kangol Ltd. v. KangaROOS U.S.A. Inc., 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992).

Applicant's major contentions are that the goods of applicant and registrant are not directly competitive; that registrant's books would be sold in book stores and purchased after careful consideration; and that applicant's goods would travel in different channels of trade and be purchased as low cost, impulse items.

The Examining Attorney has made of record evidence taken from Internet web sites of both book store chains and "online bookstores" demonstrating that book stores also offer photograph albums for purchase. Thus, in the absence of any limitations in either applicant's application or the cited registration as to channels of trade, we find this evidence fully adequate to show that the goods of both would travel in the same trade channels. Customers frequenting a book store would be likely to find photograph albums for sale as well. It goes without saying that books are also sold in many retail outlets other than formal bookstores, at least some of which would undoubtedly also offer photograph albums.

The more significant question is whether a sufficient relationship exists between these goods that customers would be likely to believe that applicant's photograph albums and registrant's books originate from a single source, if similar marks are used thereon. We find the copies of numerous third-party registrations made of record by the Examining Attorney showing registration of the same mark by a single entity for both books and photograph albums fully adequate to establish such a relationship. While these registrations are admittedly not evidence of use of the marks in commerce, they are sufficient to suggest that these goods are ones which may be produced by a single entity and marketed under the same mark. See *In re Albert Trostel & Sons Co.*, *supra*, *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467 (TTAB 1988). Accordingly, if similar marks are used on both types of goods, it may reasonably be presumed that purchasers will mistakenly believe that the goods emanate from the same source. Although applicant has raised the argument that many of the books in these registrations are "specialty books," rather than books in general, we would simply point out that the cited registration is unlimited as to the nature of the books covered thereby and thus would encompass all varieties of books.



We give little weight to applicant's attempt to distinguish between the nature of the purchases involved here. We fail to see any sharp distinction between the degree of care given to the purchase of many books and to photograph albums. Nor are we aware of any significant differences in the costs thereof. Applicant has clearly failed to present any evidence which might substantiate its arguments with respect to this factor.

Registration No. 2,181,767

Looking once again to the general principles set forth above, we agree with the Examining Attorney that the dominant element of both applicant's mark WALLABY WALLETS and design and registrant's mark WALLABIES is the term WALLABY, although presented in the plural in registrant's mark. Here also the descriptive matter of applicant's mark, the word WALLET, would not be likely to be viewed as the indicator of source. Here also the design element of applicant's mark would serve primarily to reinforce the literal portion of the mark. Furthermore, since registrant's mark is registered as a typed drawing, registrant is free to use its mark in any format, including one incorporating a "wallaby" design very similar to that of applicant. The only arguable difference in the marks, besides the merely descriptive term WALLET in applicant's

mark, is registrant's use of the plural form, which we find insignificant in terms of the overall commercial impression created by the two marks. Both are predominated by the reference to the kangaroo known as the "wallaby", an arbitrary term when used with the goods involved here.

Applicant argues that consumers would associate the mark WALLABIES with the Australian professional rugby team and this association would accordingly have an effect on the commercial impression created by the mark. There is no basis for such a conclusion, however, in the registration before us. There is no reference to any team in the mark nor is there any design element in this registration which might bring the sport of rugby to mind. We must make our comparison solely on the basis of the mark as registered, a typed drawing for the word WALLABIES. As such, we find the overall commercial impression highly similar to applicant's WALLABY WALLET mark.<sup>6</sup>

Turning to the respective goods, applicant again raises its argument of different channels of trade. The Examining Attorney has countered this argument, however,

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<sup>6</sup> Applicant's reference to various ANGEL marks and the accompanying exhibits attached to its brief have been given no consideration. As pointed out by the Examining Attorney, evidence of this nature must be made of record prior to the filing of an appeal. See Trademark Rule 2.142(d). Applicant's exhibits are untimely.

with copies of newspaper advertisements showing the offering for sale of photograph albums and many of the stationery items listed in the registration in the same retail outlets. In addition, she has made of record third-party registrations showing the registration of a single mark for both photograph albums and various items among registrant's goods. Here again the evidence is more than adequate to establish that the goods are sufficiently related that the same customers would encounter the goods of both and that these same customers would be likely to believe that all originate from a single source, if similar marks are used thereon.

The remaining factors that applicant has raised are equally applicable to both cited registrations. Thus, while applicant argues that there has been no known instances of actual confusion, we would simply note that little weight can be given to this factor in an ex parte proceeding. There has been no opportunity for either registrant to be heard from on this point. See *In re National Novice Hockey League, Inc.*, 222 USPQ 638 (TTAB 1984).

Applicant also points to the fact that the two cited registrations have been allowed to coexist on the Register. The matter before us, however, is the likelihood of

confusion of applicant's mark with each of the two marks and not between the two marks. The prior decision of an Examining Attorney on the registrability of the cited marks over one another is in no way controlling on our present decision. See *In re Nationwide Industries, Inc.*, 6 USPQ2d 1882 (TTAB 1988).

Accordingly, upon weighing all of the relevant *du Pont* factors, we find the likelihood of confusion with respect to each of the cited registrations. To the extent that there may be any remaining doubt, we follow the well-established principle that any doubt regarding likelihood of confusion must be resolved in favor of the registrant. See *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988).

Decision: The refusal to register under Section 2(d) is affirmed.